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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,546	10/15/2001	Barry J. Marshall	17127A	3538

22506 7590 07/28/2005  
JAGTIANI + GUTTAG  
10363-A DEMOCRACY LANE  
FAIRFAX, VA 22030

EXAMINER

ALEXANDER, LYLE

ART UNIT PAPER NUMBER

1743

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/977,546

Applicant(s)

MARSHALL ET AL.

Examiner

Lyle A. Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-50 and 1-63 of copending Application No. 09/977,667 and 09/977,547 respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim an apparatus comprising a carrier having at least two separated well and a specimen handling tool.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dunskey (USP 4,293,074) or Beddow (USP 4,226,328).

The cited prior art all teach a carrier comprising at least two well separated by a barrier and an hour glass shaped specimen handling tool further comprising two cooperating arms joined at one end and that form a point at the other end for grasping the specimen.

Claims 1-10, 12-26 and 28-33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Horan et al. (USP 5,339,955) or Rauschenberger (USP 4,160,505).

The cited prior art all teach a carrier comprising at least two well separated by a barrier and a specimen handling tool further comprising two cooperating arms joined at one end and that form a point at the other end for grasping the specimen.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 11 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horan et al. (USP 5,339,955) or Rauschenberger (USP 4,160,505) in view of Dunskey (USP 4,293,074) or Beddow (USP 4,226,328).

See these references supra.

Horan et al. (USP 5,339,955) and Rauschenberger (USP 4,160,505) are silent to the "hourglass" shape of the sample handling tool.

Both Dunskey (USP 4,293,074) and Beddow (USP 4,226,328) teach it is known to use an hourglass shaped tools. This shape is advantageous because it readily fits into the human hand and permits a greater application of force.

It would have been within the skill of the art to modify Horan et al. (USP 5,339,955) or Rauschenberger (USP 4,160,505) in view of Dunskey (USP 4,293,074) or Beddow (USP 4,226,328) and use an hour glass shaped specimen handling tool to gain the above advantages.

### ***Response to Arguments***

Applicant's arguments filed 5/5/05 have been fully considered but they are not persuasive.

Applicants' remarks addressing the Double Patenting rejections were not clear if a terminal disclaimer has been filed or will be filed in the future. No terminal disclaimer has been received by the Office for the instant application.

Applicants' amendments are acknowledged and appreciated. However, other than clarifying the 35 USC112 second paragraph issues, the do not appear to significantly change the scope of the claims. Applicants' state Horan et al. (USP 5,339,955), Rauschenberger (USP 4,160,505), Dunskey (USP 4,293,074) and Beddow (USP 4,226,328) all fail to teach the invention as presently claimed. Specifically, Applicants' state these references fail to teach the physical separation of the wells and fail to teach wells that can be broken into separate portions. The Office maintains the instant claim language is sufficiently broad to have been properly read on the cited prior art that clearly teach the claimed first and second wells. Furthermore, the instant claims are directed to an apparatus and the court has well settled the method of intended use of an apparatus is of no patentable moment to the pending apparatus claims as long as the cited apparatus has the capability to perform the same function. The Office

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maintains all of the cited prior art references have the capability of being broken into two separate pieces as presently claimed and have been properly applied.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

Lyle A Alexander  
Primary Examiner  
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[direct.uspto.gov](http://direct.uspto.gov). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).